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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,806	10/21/2003	Steven P. Barton	112703-294	6662

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EXAMINER

SHAPIRO, JEFFERY A

ART UNIT PAPER NUMBER

3653

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/691,806

Applicant(s)

BARTON ET AL.

Examiner

Jeffrey A. Shapiro

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 44-68,76 and 102-111 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 44-68,76 and 102-111 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>8/16/04</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 44, 48-50, 56, 65, 67, 76 and 102-111 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perlin, Jr. et al (US 6,356,794 B1) in view of Dejaeger et al (US 6,213,395 B1). Perlin discloses the following.

As described in Claims 44, 48-50, 56, 65, 67, 76 and 102-111;

- a. allowing a consumer to bring purchasable items to a checkout device (33);
- b. scanning the items and accumulating a cost for the scanned items on a display (33) (see Perlin, col. 4, lines 18-24);
- c. allowing the consumer to select a product from a dispensing device (29) located in juxtaposition to the automated checkout;
- d. automatically dispensing the product from the dispensing device in response to the consumer's selection (see Perlin, col. 4, lines 24-31); and
- e. automatically adding a cost of the product to the cost for the scanned items on the display (see Perlin, col. 4, lines 42-56, col. 5, lines 12-21, (note that the credit value is entered into the POS terminal (33) and retail module (38));

Perlin does not expressly disclose, but Dejaeger discloses the following.

As described in Claims 44, 48-50, 56, 65, 67, 76 and 102-111;

- f. allowing a consumer to bring purchasable items to an *automated* checkout device (10) (see Dejaeger, abstract, for example);
- g. *allowing the consumer to scan* the purchasable items and accumulate a cost for the scanned items on a display (see Dejaeger, abstract, for example);

Both Perlin and Dejaeger are considered to be analogous art as they both concern use of checkout counters at a retail point of sale (POS) system.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have replaced the checkout counter of Perlin with the checkout counter of Dejaeger.

The suggestion/motivation would have been to provide a checkout counter which can be used in either a self-service or assisted checkout mode. See Dejaeger, col. 2, lines 61-67, col. 3, lines 1-16, col. 4, lines 3-12 and col. 6, lines 5-38.

3. Claims 45-47, 51-55, 57-61, 66, 68 and 102-111 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perlin, Jr. et al (US 6,356,794 B1) in view of

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Dejaeger et al (US 6,213,395 B1) and further in view of Walter. Perlin and Dejaeger disclose the apparatus as described above. Perlin further discloses the following.

As described in Claims 46, 51 and 60;

- h. including the step of allowing the consumer to pay for the product by credit/debit card (see Perlin, col. 4, lines 18-22);

As described in Claim 47;

- i. adding the cost of the product includes automatically increasing a balance due on a credit/debit card transaction (see Perlin, col. 4, lines 18-22, noting that this is how credit card systems work);

As described in Claims 54, 55, 58 and 59;

- j. allowing a retail operator or customer to enter the consumer's approval to purchase the product (see Perlin, col. 4, lines 18-22);

As described in Claim 68;

- k. the point of purchase product is dispensed from a device that is integral with the device that identifies costs (see Perlin, figure 2, for example);

Perlin does not expressly disclose, but Walter discloses the following;

As described in Claim 45;

- l. the consumer selects the product by using a touch screen (32) (see Walter, col. 4, lines 64-67);

As described in Claim 52;

- m. the consumer is prompted that the product is available by an advertisement for the product (64)(see Walter, figure 6 and col. 9, lines 34-41) ;

As described in Claims 53, 61 and 66;

- n. prompting the consumer includes prompting the consumer at a time selected from the group consisting of:
  - i. before the consumer purchases the other consumable items,
  - ii. while the consumer is purchasing the other items and
  - iii after the consumer purchases the other items;

(Note that the instructions, which include advertisements are intended to be advertisements which are periodically placed in the message area, and that the animated character (62), which may be in the form of a product, is intended to be in view of the customer all of the time. See col. 9, lines 9-14. Note also that each element of the group is considered to be a functional equivalent of each other.)

As described in Claim 57;

- o. prompting the consumer that the products are available includes displaying a dynamic display selected from the group consisting of:
  - i. a display of the products (see figure 6, element (62),
  - ii. a message concerning the products (see fig. 6, element (64),

- iii. an advertisement concerning the products (see fig. 6, elements 62 and 64), and
- iv. a price reduction concerning the products (note that it would have been obvious to provide a message such as this as it is considered to be another form of advertising);

(Note that the instructions, which include advertisements are intended to be advertisements which are periodically placed in the message area, and that the animated character (62), which may be in the form of a product, is intended to be in view of the customer all of the time. See col. 9, lines 9-14. Note also that each element of the group is considered to be a functional equivalent of each other.)

Perlin, Dejaeger and Walter are considered to be analogous art as they concern use of checkout counters at a retail point of sale (POS) system.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have used a touch screen for the display and to use the instructional prompts, messages and advertisements in the checkout counter system of Perlin, as taught by Walter.

The suggestion/motivation would have been to provide a checkout counter which "provides instruction to a customer while also conveying an advertising message." See Walter, col. 3, lines 23-27, col. 4, lines 58-67 and col. 6, lines 10-22. Note also that a

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touch screen is construed to be a functional equivalent to a non-touch display or a voice generation device.

4. Claims 44, 48-50, 56, 65, 67, 76 and 102-111 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bustos (US 5,816,443) in view of Walter et al (US 5,992,570). Bustos discloses the following.

As described in Claims 44, 48-50, 56, 65, 67, 76 and 102-111 ;

- a. allowing a consumer to bring purchasable items to a checkout device (see Bustos, fig. 5a);
- b. scanning the items and accumulating a cost for the scanned items on a display (33) ((see Bustos, fig. 1, which illustrates a monitor near element (127) and fig. 5a, which illustrates a clerk scanning items);
- c. allowing the consumer to select a product(47b) from a dispensing device (20b) located in juxtaposition to the automated checkout (see Bustos, fig. 5a);
- d. automatically dispensing the product from the dispensing device in response to the consumer's selection (see Bustos, fig 5a); and
- e. automatically adding a cost of the product to the cost for the scanned items on the display (see Bustos, col. 8, lines 1-49);

Bustos does not expressly disclose, but Walter discloses the following.



As described in Claims 44, 48-50, 56, 65, 67, 76 and 102-111 ;

- f. allowing a consumer to bring purchasable items to an *automated* checkout device (10) (see Walter, col. 2, lines 15-19, for example);
- g. *allowing the consumer to scan* the purchasable items and accumulate a cost for the scanned items on a display (see Walter, Claim 8, for example);

Both Bustos and Walter are considered to be analogous art as they both concern use of checkout counters at a retail point of sale (POS) system.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have replaced the checkout counter of Bustos with the checkout counter of Walker.

The suggestion/motivation would have been to speed customer throughput by speeding up the checkout process. See Walter, col. 2, lines 15-19.

### ***Response to Arguments***

5. Applicant's arguments filed 8/16/04 have been fully considered but they are not persuasive. Applicant argues that Bustos and Perin teach away from an automated checkout. However, Bustos can be construed to be an automated checkout. Bustos states in col. 8, lines 1-5 that the customer may add to his gasoline purchase the selection and purchase of a beverage. Col. 8, lines 9-14 indicate that the billing system communicates with the gasoline vending system as well as the dispensers (20). Based on lines 1-5, one of ordinarily skilled in the art would have recognized that the vending

unit located next to the point of sale or at the cash register. Also, col. 8, lines 42-49 clearly indicate that "a product order can be processed from a selection on the panel (22), charging the price directly to the pending transaction being processed at the checkout lane cash register."

Again, Dejaeger discloses a self-service checkout system. Based on the teaching of Dejaeger, it would have been obvious to one ordinarily skilled in the art to have substituted a manually operated cashier station with a self-service checkout system, so as to automate checkout operations, thereby reducing the need for employees. See the discussions outlined above.

Regarding the argument that Bustos discloses remote storage versus storage of items on or at the point of sale, at the very least, it would have been obvious to reduce the length of pipe from the storage device located on the ceiling, as shown in Bustos, figure 1. Further, one could construe the storage unit (25) of Bustos as being located proximate, since it is within the same building rather than outside the building (15). In other words, the term "proximate" versus "remote" are very broad terms that can be construed such that Bustos' storage area can be read as being "proximate" to the checkout (24). Regarding applicant's argument that Bustos does not prompt the consumer to purchase a product from the dispensing device, see Bustos, figure 5D, which shows in inset, upper left-hand corner, menu (106), which can be construed to "prompt" the consumer to purchase a particular item located on the menu. Again, Applicant's claim limitations are sufficiently broad so as to invite such interpretations. Regarding Walter, note that Walter is only being used for its teaching of automating a

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manually staffed checkout counter with an automated self-checkout counter. Bustos provides the teaching for dispensing products at a point of purchase and combining the cost of those items with other items purchased. Again, note the gasoline example cited above. Regarding consumable versus non-consumable items, it is construed that regardless of the status of the item, the system will work equally the same with either consumable or non-consumable items.

Therefore, Claims 44-68, 76 and 102-111 are rejected.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

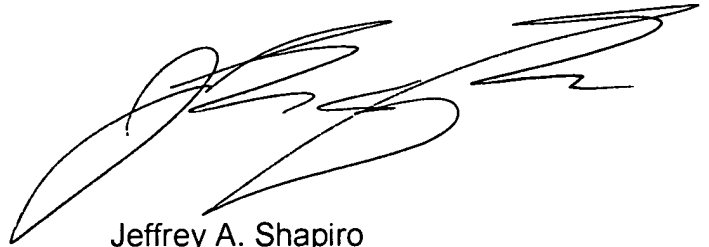
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Shapiro whose telephone number is (703)308-3423. The examiner can normally be reached on Monday-Friday, 9:00 AM-5:00 PM.

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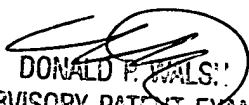
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald P. Walsh can be reached on (703)306-4173. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey A. Shapiro  
Examiner  
Art Unit 3653

December 9, 2004



DONALD P. WALSH  
SUPERVISORY PATENT EXAMINER  
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